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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,192	09/21/2001	Douglas B. Adams	BLD920010009US1	8223

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EXAMINER
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SHEIKH, ASFAND M

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/961,192	<b>Applicant(s)</b> ADAMS ET AL.	
	<b>Examiner</b> Asfand M. Sheikh	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 15-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 16-Jan-2007.

2. Applicant's election with traverse of invention II in the reply filed on 16-Jan-2007 is acknowledged. The traversal is on the ground(s) that alleged inventions do not justify separate searches. This is not found persuasive because the examiner notes that the subject matter found in invention I and invention II would require separate searches. If the applicant believes that the inventions are not distinct, the examiner requests that the applicant state on the record that invention I and invention II are not patentable distinct between each other.

The requirement is still deemed proper and is therefore made FINAL.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2, 8, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al.

As per claim 1, 8, 11, and 12, Smith et al. teaches a portable computing device used for asset tracking (Smith et al, see at least, abstract, 0034), a database located on the portable computing device (Smith et al, see at least, abstract, 0034 and FIG. 3), wireless interface adapted for connecting the portable computing device to a network via a wireless access protocol (Smith et al, see at least, abstract, 0028), a global positioning system (GPS attached to the portable computing device (Smith et al, see at least, 0053), asset tracking software, installed on the portable computing device, for receiving asset GPS location via the wireless interface, and for

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updating the asset data via the wireless interface (Smith et al, see at least, abstract, abstract and 0034 and FIG. 3).

The examiner notes Smith et al. is silent with respect to knowledge base software installed on the portable computing device.

Horton et al. teaches knowledge base software installed on the portable computing device (Horton et al., see at least, abstract, col. 3, lines 40-49, col. 5, lines 60-67 and col. 6, lines 1-3).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith et al. to include knowledge base software installed on the portable computing device as taught by Horton et al. One of ordinary skill in the art would have been motivated to combine the teachings in order to analyze multiple sources of information and derive a sound strategy that will allow the user to assess the assets situation (Horton et al., see at least col. 3, lines 20-49).

As per claim 2, the examiner notes that Smith et al. is silent with respect to wherein the knowledge based software includes at least one of a diagnostic module adapted to conduct

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diagnostic tests on the asset, a data entry module adapted to record information, and a barcode scanning module adapted to scan a barcode on the asset.

Horton et al. teaches knowledge base software installed on the portable computing device that includes a diagnostic module adapted to conduct diagnostic tests (Horton et al., see at least, abstract, col. 3, lines 40-49, col. 5, lines 60-67 and col. 6, lines 1-3 and 21-27).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith et al. to include knowledge base software installed on the portable computing device that includes a diagnostic module adapted to conduct diagnostic tests as taught by Horton et al. The motivation to combine is the same as claim 1, above.

5. Claim 3 and 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al. as applied to claim 1 above, and further in view of Morris et al.

The combination of Smith et al. in view of Horton et al. teaches knowledge base software installed on the portable computing device (refer to claim 1 and motivation to combine).

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The examiner notes that the combination of Smith et al. in view of Horton et al. is silent with respect to software that includes a time tracking module adapted to track user time, a work order management module adapted to manage work orders, and a billing module adapted to generate billing information.

Morris et al. teaches that software that includes a time tracking module adapted to track user time, a work order management module adapted to manage work orders, and a billing module adapted to generate billing information (Morris et al, see at least, col. 6, lines 11-22).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Smith et al. in view of Horton et al. to include software that includes a time tracking module adapted to track user time, a work order management module adapted to manage work orders, and a billing module adapted to generate billing information as taught by Morris et al. One of ordinary skill in the art would have been motivated to combine the teachings in order to improve tracking service work (Morris et al., see at least, col. 2, lines 3-6).

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6. Claim 4 and 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al. as applied to claim 1 above, and further in view of Edgar.

The combination of Smith et al. in view of Horton et al. teaches knowledge base software installed on the portable computing device (refer to claim 1 and motivation to combine).

The examiner notes that the combination of Smith et al. in view of Horton et al. is silent with respect to receiving electronic signatures on the portable computing device.

Edgar teaches receiving electronic signatures on the portable computing device (Edgar et al., see at least, abstract).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Smith et al. in view of Horton et al. to include receiving electronic signatures on the portable computing device as taught by Edgar. One of ordinary skill in the art would have been motivated to combine the teachings in order to verify the release information regarding the asset (Edgar et al, see at least, col. 6, lines 28-45).



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7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al. as applied to claim 1 above, and further in view of Morrow et al.

The combination of Smith et al. in view of Horton et al. teaches knowledge base software installed on the portable computing device (refer to claim 1 and motivation to combine).

The examiner notes that the combination of Smith et al. in view of Horton et al. is silent with respect to software that includes instant messaging software.

Morrow et al. teaches software that includes instant messaging software (Morrow et al, see at least, 0037 and 0041).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Smith et al. in view of Horton et al. to include software that includes instant messaging software as taught by Morrow et al. One of ordinary skill in the art would have been motivated to combine the teachings in order be able to reach user of the portable computing device in a quick and efficient manner.

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8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al. as applied to claim 1 above, and further in view of Park et al.

The combination of Smith et al. in view of Horton et al. ass tracking software (refer to claim 1 and motivation to combine).

The examiner notes that the combination of Smith et al. in view of Horton et al. is silent with respect to a travel calculating module adapted to calculate travel time from a first location to second location.

Park et al. teaches a travel calculating module adapted to calculate travel time from a first location to second location (Park et al., see at least, col. 2, lines 27-43 and col. 5, lines 11-22).

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Smith et al. in view of Horton et al. to include travel calculating module adapted to calculate travel time from a first location to second location as taught by Park et al. One of ordinary skill in the art would have been motivated to combine the teachings in order provide accurately compute an average time and speed taken for

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traveling from a start point to an end point (Park et al., see at least, col. 5, lines 56-61).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al. as applied to claim 1 above, and further in view of Examiner's Official Notice.

The combination of Smith et al. in view of Horton et al. teaches asset tracking software (refer to claim 1 and motivation to combine).

The examiner notes that the combination of Smith et al. in view of Horton et al. is silent with respect to a mapping module adapted to provide a real-time map based on a GPS location of the tool.

The examiner takes official notice that it is old and well known to have a module to display real-time map on a portable computing device (e.g. handheld GPS navigation system) in order to provide accurate representation of the roads that one travels on.

The examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Smith et al. in

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view of Horton et al. to include ~~x~~ a module to display real-time map on a portable computing device as taught by Examiner's Official Notice because it provides accurate representation of the roads that one travels on.

10. Claims 13-14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Horton et al and in view of Morris et al.

The examiner notes that the limitations of claims 13-14 and 22 are substantially similar to those of claims 1 and 3, and therefore are rejected under similar grounds. Similar motivation is used to combine the references.

#### ***Response to Arguments***

11. Applicant's arguments filed 16-Jan-2007 have been fully considered but they are not persuasive.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Asfand M Sheikh  
Examiner  
Art Unit 3627

ams  
20-Mar-07

  
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SUPERVISORY PATENT EXAMINER